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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,651	04/13/2001	Yasuhiro Nakai	1275-44	1740
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NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			PILLAI, NAMITHA	
			ART UNIT	PAPER NUMBER
			2173	

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/833,651

Applicant(s)

NAKAI ET AL.

Examiner

Namitha Pillai

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9 is/are allowed.
- 6) ☒ Claim(s) 1-8, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/14/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Examiner acknowledges Applicant's submission on 11/10/05 with amendments to claims 1, 3-6 and the addition of new claim 11. Claims 1-8 and 10-11 have been rejected as being previously disclosed or obvious over prior references.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 12/14/05 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims ^{2, 10}1 ^{are} as amended on 11/10/05 ~~is~~ rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The amended claim(s) contains subject matter, specifically in reference to the feature of print conditions being displayed on the display picture in a recognizable display form "when the file icon is not located over the print icon" which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Since claims 2 and 10 depend on claim 1 and include all of the limitations of this claim, claims 2 and 10 are rejected under 35 U.S.C. 112, first paragraph.

RS

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 5,546,527 (Fitzpatrick et al.), herein referred to as Fitzpatrick and U. S. Patent No. 5,638,505 (Hemenway et al.), herein referred to as Hemenway.

Referring to claim 1, Fitzpatrick discloses a print control operation system using icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed, print processing of the file being executed under the predetermined print conditions in the print icon by dragging the file icon and dropping the file icon on the print icon (Figure 4 and column 1, lines 21-30). Fitzpatrick discloses that print icon is formed so that the display is altered to a setting of the print conditions, wherein the print icon is formed to have default print conditions (column 1, lines 27-30). Fitzpatrick also discloses the predetermined print conditions in the print icon being displayed on the display picture in a recognizable display form (Figure 4 and column 2, lines 11-13) but discloses that the print conditions are displayed by locating the file icon on the print icon. Hemenway carries out the same methods as disclosed by Fitzpatrick of dragging and dropping a file icon on to a print icon in order to print the contents of the file icon (column 1, lines 65-67 and column 2, lines 1-5). Hemenway in addition to that, also displays the print conditions in a

recognizable display form when the file icon is not located over the print icon, wherein this print information is always displayed (reference number 46, Figure 3A). It would have been obvious for one skilled in the art at the time of the invention to display the print conditions in a recognizable display form when the file icon is not located over the print icon. Hemenway and Fitzpatrick both teach printing files through icon manipulation, wherein a file icon is dragged and dropped onto a print icon in order for that distinct printer to print the file. Hemenway furthermore allows for the user to view the print conditions without an additional dragging process, wherein this convenient method can be beneficial in Fitzpatrick's disclosure, wherein the user can view the print conditions before dragging the file icon. Furthermore, Fitzpatrick teaches prior art and well known methods in the field of printer processing, wherein the user had access to a printer icon containing printer conditions, wherein a direct access of the user by clicking on this printer icon would allow for the print conditions to be displayed on the display picture in a recognizable display form when the file icon is not located over the print icon (column 1, lines 35-50). Hemenway further teaches the methods as discussed above.

Referring to claim 2, Fitzpatrick discloses that at a time point when a file icon of a file to be printed is superposed on the print icon, an outline of the print conditions preset in the print icon are displayed on the display picture (Figure 4 and column 2, lines 32-37).

Referring to claim 10, Fitzpatrick discloses that at a time point when a file icon of a file to be printed is superposed on the print icon, a printing preview of the file icon is displayed on the display picture, wherein the print parameters which apply to the file

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icon for printing inherently teaches a preview means for the previewing of the file icon (Figure 4), further as per the present claims, a preview is available of the file icon, wherein the file icon is displayed to the user when the file icon is superposed onto the printer icon as shown in Figure 3, wherein this display of the file icon allows the user to have a print preview of the file icon, wherein the file that is to be printed, is previewed, thus teaching a printing preview of the file icon.

5. Claims 3, 5-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 5,546,527 (Fitzpatrick et al.), herein referred to as Fitzpatrick and U. S. Patent No. 6,697,090 B1 (Nagasaka et al.), herein referred to as Nagasaka.

Referring to claim 3, Fitzpatrick discloses a print control operation system using icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed, print processing of the file being executed under the predetermined print conditions in the print icon by dragging the file icon and dropping the file icon on the print icon (Figure 4 and column 1, lines 21-30). Fitzpatrick discloses that the print conditions in the print icon are displayed on the display picture in a recognizable display form (Figure 4 and column 2, lines 11-13). Fitzpatrick discloses at a time point a file icon of a file to be printed is superposed on the print icon, a printing preview of the file icon is displayed on the display picture, wherein the print parameters which apply to the file icon for printing inherently teaches a preview means for the previewing of the file icon (Figure 4), further as per the present claims, a preview is available of the file icon, wherein the file icon is displayed to the user when the file icon is superposed onto the printer icon as shown in Figure 3, wherein this

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display of the file icon allows the user to have a print preview of the file icon, wherein the file that is to be printed, is previewed, thus teaching a printing preview of the file icon. Fitzpatrick disclose displaying a printing preview of the file icon but does not disclose providing preview data that displays what is contained within this file icon. Nagasaka discloses providing a preview of items found within an icon object that is displayed as a result of superposing a first object icon onto a second object icon (column 8, lines 5-25). It would have been obvious for one skilled in the art, at the time of the invention, to disclose providing a preview of items associated with an icon when a first icon is superposed on a second icon. Nagasaka teaches an analogous art of drag and drop of icons including image document icons with printer icons for carrying out distinct functionalities. Nagasaka in addition to teaching the drag and drop of icons for carrying out functionality, further teaches that upon superposing of a first icon onto a second icon, a preview of items that are associated with the icon is displayed to the user, without actual selection and display within an application. Therefore, Fitzpatrick having taught the drag and drop functionality could further benefit by providing a print preview of the items as is taught by Nagasaka. Nagasaka's drag and drop functionality further allows for viewing of data related to the icons that are superposed without manual selection of the icons within an application primarily for previewing of the items. This feature would be beneficial to Fitzpatrick where using the same drag and drop functionality, the user of Fitzpatrick would be able to carry out multiple steps including directing the printing of documents along with previewing of items associated with the icons. Hence, one skilled in the art, at the time of the invention would have been

motivated to learn from Nagasaka to teach providing a preview of a items associated with an icon when a first icon is superposed on a second icon.

Referring to claim 5, Fitzpatrick discloses when a file icon of a file to be printed is dragged and dropped on the print icon, a window for setting print conditions of the print icon is opened (column 2, lines 47-50 and Figure 4).

Referring to claim 6, Fitzpatrick discloses when a file is dragged and dropped on the print icon, a printer capable of conducting print processing is automatically selected based on print conditions set in the print icon, wherein once the file icon is dropped onto a print icon, from within the parameters disclosed, the specific printer is determined (column 4, lines 1-4).

Referring to claim 7, Fitzpatrick discloses when a tile icon is dragged and dropped on the print icon, a printer capable of conducting a print processing is automatically selected from among printers in a stand-by state, based on print conditions set is the print icon (column 3, lines 58-60 and column 4, lines 1-4).

Referring to claim 8, Fitzpatrick discloses a printer to be used is set in the print icon as one of set conditions of the print icon (column 4, lines 1-4). Fitzpatrick discloses monitoring the target print icons to determine if the state of the printer is monitored such that the printer cannot execute processing set in the print icon, the print icon is controlled so as not to be displayed (column 6, lines 24-30), wherein Fitzpatrick teaches upon determining that the printer target is cannot do processing will ensure that the print icon is not to be displayed and not accessible for manipulation.

Referring to claim 11, Fitzpatrick and Nagasaka discloses that the printing preview allows a user to view and confirm contents of a file to be printed without having to open the file on an application (Nagasaka, Figure 9 and column 8, lines 30-35), teaching that the information provided for previewing is done so without opening an application and where the display shows simply the items without any relation to a specific application under which the items have been accessed.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 5,546,527 (Fitzpatrick et al.), herein referred to as Fitzpatrick and U. S. Patent No. 6,697,090 B1 (Nagasaka et al.), herein referred to as Nagasaka and further in view of Hemenway.

Referring to claim 4, Fitzpatrick and Nagasaka do not explicitly imply a plurality of file icons of files to be printed being dragged and dropped on the printer icon and further determining that the files are consecutively subject to print processing. Hemenway much like Fitzpatrick, allows for a drag and drop means for dragging file documents and dropping them onto print icons for printing to occur, wherein Hemenway goes further to display to teach that multiple print jobs are applicable to the one print icon (Figure 5C and column 11, lines 28-31), wherein printer Spitfire discloses having multiple files icons to be printed. It would have been obvious for one skilled in the art, at the time of the invention to learn from Hemenway to implement a means for a plurality of file icons of files to be printed by dragging and dropping the files onto the print icon, the files being consecutively printed as a series of recorded matters. It is necessary to have a method for printing various documents, which is necessary for users of any computer system.

Thus, as Hemenway teaches, the ability to drag and drop a plurality of documents on to the print source or icon allows for the print jobs to be queued to be processed consecutively, thus allowing for various documents to be printed at the same time.

Response to Arguments

7. Applicant's arguments filed 11/10/05 have been fully considered but they are not persuasive.

With reference to claim 3, based on further consideration, it has been determined that previewing of data items associated with an icon object as a result of superposing of the icon has been disclosed in prior arts. Based on discussions with Primary Examiners, it has been determined that these new additional features have been previously disclosed. Claim 3 has been rejected as being obvious over Fitzpatrick and Nagasaka. Nagasaka has taught a drag and drop method using print and image icons with one drag and drop function allowing for previewing of data that is associated with the icons that have been superposed. Based on these findings, claim 3 is not allowable.

With reference to claim 1, the Examiner has considered the new amendments to claim 1 but there is no clear support for these newly added features in the disclosure. It is suggested that Applicant point out indicating by page and line numbers, where these new features have been disclosed in the specification. The 112, first paragraph rejection for claim 1 has been maintained.

The teaching of displaying print conditions in a recognizable display form when the file icon is not located over the print icon is a well-known and common feature in the

field of word processing document. This feature is merely a common process that is found in various word processing documents. The print conditions are easily accessible and viewed on a recognizable display form in any word processing document that would allow a user to print and provide print conditions to the user to view. These word processing documents would not require that a file icon be located over the print icon, therefore displaying the print conditions to the user when the file icon is not located over the print icon. Hemenway is such a word processing system, that allows for users to view print conditions and allows viewing of these print conditions when a file icon is not located over the print icon. The display of print conditions at any time without prompting by locating an icon over another icon is clearly taught by Hemenway and in combination with Fitzpatrick, with both being analogous arts, teaches that print conditions are displayed when the file icon is not located over the print icon. The combination of Fitzpatrick and Hemenway is a proper combination that teaches the features of the present invention. Hemenway has provided a teaching of displaying the print conditions without superposing of icons. Furthermore, based on the above reference to the displaying of print conditions being common in the field of word processing, Fitzpatrick has clearly pointed out well known methods where print conditions are viewed in a recognizable form by a user without superposing of icons where print conditions although manually accessed are nonetheless viewable without being prompted by the location of print and file icons (column 1, lines 40-48). This reference by Fitzpatrick to a well known teaching clearly point outs the display of print conditions without moving of icons along with Hemenway further teaching the display of print conditions without drag

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and drop of print and file icons, clearly teaches the role of this well known feature in the field of word processing. Therefore, there is motivation provided by Fitzpatrick that would allow for a proper combination with Hemenway.

Conclusion

8. Responses to this action should be submitted as per the options cited below: The United States Patent and Trademark Office requires most patent related correspondence to be: a) faxed to the Central Fax number (571-273-8300) b) hand carried or delivered to the Customer Service Window (located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), c) mailed to the mailing address set forth in 37 CFR 1.1 (e.g., P.O. Box 1450, Alexandria, VA 22313-1450), or d) transmitted to the Office using the Office's Electronic Filing System.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namitha Pillai whose telephone number is (571) 272-4054. The examiner can normally be reached on 8:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571) 272-4048.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published

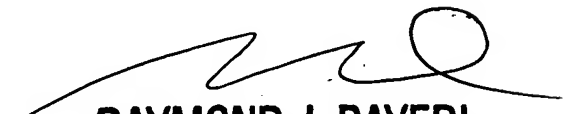
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in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Namitha Pillai
Assistant Examiner
Art Unit 2173
January 19, 2006



RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173